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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Joseph D. Rutledge

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8717

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09/10/2004

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EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2645

9

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,580

Applicant(s)

RUTLEDGE ET AL.

Examiner

Md S Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 06/09/04. Claims 1-17 are pending.

Response to Arguments

2. Applicant's arguments mailed on 06/09/04 have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilk (U.S. Patent No. 6,768,789).

Regarding claim 1, Wilk teaches a wireless telephone 28 (i.e., telephone) (fig.1).

Wilk teaches a storage device (i.e., means) for producing n pre-recorded messages (i.e., greetings) where n is an integer of one or greater (fig.1, 2; col.2, lines 36-41, col.4, lines 10-31, col.5, lines 34-36).

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Wilk further teaches keypad (i.e., means) for selecting one of the n pre-recorded messages after the wireless telephone 28 has begun to ring (fig.2; col.2, lines 36-41, col.5, lines 34-48).

Regarding claim 2, Wilk teaches local base station (i.e., means) for inherently stopping the telephone from ringing when the means for selecting is activated (fig.1, 2; col.3, lines 50-55, col.5, lines 12-16, 49-51, 57-62).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Shnier (U.S. Pub. No. 2002/0009184).

Regarding claim 3, Wilk fails to teach "each of said n greetings comprise a message indicating a time when a call will be returned as a function on n". Shnier teaches each of the n greetings comprising a message indicating a time when a call will be returned as a function on n (page 6, paragraph 0065). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilk to allow each of the n greetings comprising a message indicating a time when a call will be returned as a function on n as taught by Shnier. The motivation for the modification is to have doing so in order to provide a reminder to the caller to callback at a later time.

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7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Cronin (U.S. Patent No. 6,216,016).

Regarding claim 4, Wilk fails to teach "a first of said n greetings comprises a message instructing a caller to hold". Cronin teaches a first of the n greetings comprising a message instructing a caller to hold (col.1, lines 58-61). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilk to allow a first of the n greetings comprising a message instructing a caller to hold as taught by Cronin. The motivation for the modification is to have doing so in order to allow a moment for the called party so that he can answer the call.

8. Claims 5, 8, 10, 9, 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Chen (U.S. Patent No. 6,009,444).

Regarding claim 5 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Wilk fails to teach that means for determining how many times the greeting button has been pushed and the selected message corresponding to a number of times the greeting button was pushed. Chen teaches means for determining how many times the key 1 (i.e., greeting button) has been pressed (i.e., pushed) and the Chinese phonetic symbol (i.e., selected message) corresponding to a number of times the greeting button was pushed (fig.1; col.3, lines 11-31). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilk to allow means for determining how many times the greeting button has been pushed and the selected message corresponding to a number of times the greeting button was pushed as

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taught by Chen. The motivation for the modification is to have doing so in order to produce different symbols using the same key.

Regarding claims 8, 13 and 17, Wilk teaches means for storing a caller's message (col.5, line 65- col.6, line 4).

Regarding claim 9, Wilk teaches inherently an indicator on the telephone for notifying (i.e., reminding) that a call has been received (col.5, lines 12-16).

Regarding claims 10 and 14 are rejected for the same reasons as discussed above with respect to claim 5.

Regarding claims 12 and 16, Wilk teaches obtaining the caller's telephone number (col.5, lines 12-16).

Wilk further teaches including the caller's telephone number in the selected greeting (col.4, lines 10-31, col.5, lines 12-16, 34-48).

9. Claims 6, 7, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (U.S. Patent No. 6,768,789) and in view of Shnier (U.S. Pub. No. 2002/0009184).

Regarding claims 6, 7, 11 and 15 are rejected for the same reasons as discussed above with respect to claim 3.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rydbeck (U.S. Patent No. 6,574,471) teach Apparatus and method for handling incoming calls received by a portable intelligent communications device during a meeting.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703) 305-4822.

The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE
August 30, 2004

ALLAN HOOSAIN
PRIMARY EXAMINER for
Fan Tsang